

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Application No.: 09/223,901

Customer No.: 22927

Attorney Docket No.: 98-084

Date Filed: December 31, 1998

Title: SYSTEM AND METHOD FOR ENCOURAGING
COMPETITIVE PARTICIPATION IN AN AUCTION

Applicants: WALKER et al.

Group Art Unit: 3639

Examiner: ROBINSON BOYCE, Akiba K.
(571) 272-6734 /voice
(571) 273-8300 /fax

Renewed Petition under 37 CFR 1.137(b)

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir or Madam:

In response to the Decision on Petition mailed February 28, 2006, please enter the enclosed petition and consider the following remarks.

REMARKS

On November 30, 2005, Applicants filed a Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(b), concurrently with a Request for Continued Examination and Response. In the Decision on Petition mailed February 28, 2006 (copy enclosed), that petition was dismissed because it was not accompanied by a terminal disclaimer as required by MPEP § 711.03(c) subpart G.

Applicants herein re-submit copies of the Petition for Revival, Response to Office Action, and Request for Continued Examination as originally filed on November 30, 2005. In accordance with MPEP § 711.03(c) subpart G, Applicants herein enclose the required Terminal Disclaimer (and fee) and respectfully request renewal of the petition under 37 CFR 1.37(b).

AUTHORIZATION TO CHARGE APPROPRIATE FEES

Applicants hereby petition for a **one-month** extension of time with which to respond to the Decision on Petition. Please charge **\$250.00** for this petition to our Deposit Account No. 50-0271 (one month extension plus Terminal Disclaimer fee). Please charge any additional fees that may be required for this Renewed Petition, or credit any overpayment to Deposit Account No. 50-0271.

CONCLUSION

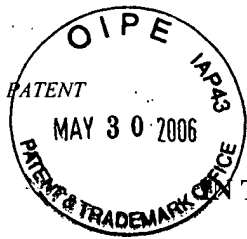
It is submitted that enclosure of the required Terminal Disclaimer (and fee) and copies of the Petition, Response, and RCE previously filed on November 30, 2005 complete Applicants' Petition under 37 CFR 1.137(b). Applicants respectfully request acceptance of this Renewed Petition and timely examination of the enclosed Amendment and Response.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Stephan Filipek at telephone number (203) 461-7252 or via electronic mail at sfilipek@walkerdigital.com.

Respectfully submitted,

May 25, 2006
Date


Stephan J. Filipek
Attorney for Appellants
Registration No. 33,384
sfilipek@walkerdigital.com
(203) 461-7252 /voice
(203) 461-7300 /fax



Application No. 09/223,901
Attorney Docket No.: 98-084

THE UNITED STATES PATENT AND TRADEMARK OFFICE

CUSTOMER NO. 22927

Applicants: Walker et al.
Application No.: 09/223,901
Filed: December 31, 1998
Title: SYSTEM AND METHOD FOR ENCOURAGING COMPETITIVE
PARTICIPATION IN AN AUCTION
Attorney Docket No. 98-084

Group Art Unit: 3639
Examiner: ROBINSON BOYCE, Akiba K.

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**NOTIFICATION OF LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
PURSUANT TO 37 CFR 1.27 (g) (2)**

Dear Sir:

Please change the fee status of the above-identified application from a small entity to a large entity. This notification is made pursuant to 37 CFR §1.27(g)(2). The assignee of the above-identified application no longer claims small entity status. Therefore, please change the fee status of the application to that of a large entity. Also, change the fee status of any continuing applications claiming benefit under 35 USC §§ 119(e), 120, 121, or 365(c).

If the Examiner has any questions about this status change, the Examiner is invited to contact the undersigned at (203) 461-7252. While no fees are believed due in connection with this paper, please charge any fees that may be required for this paper, or with any other papers filed in connection with this application to Deposit Account No. 50-0271. A duplicate copy of this sheet is enclosed for such purpose.

Respectfully submitted,

Stephan J. Filipek
Attorney for Applicants
Walker Digital, LLC
Registration No. 33,384
(203) 461-7252/direct
(203) 461-7300/fax

May 25, 2006
Date

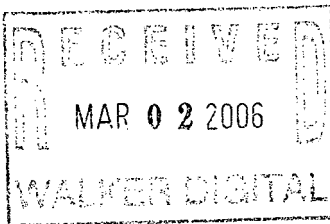
98-084
R22

UNITED STATES PATENT AND TRADEMARK OFFICE



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

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STAMFORD, CT 06905



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FEB 28 2006

OFFICE OF PETITIONS

In re Application of Walker et al.
Application No. 09/223,901
Filing Date: December 31, 1998
Attorney Docket No. 98-084

Decision on Petition

COPY

This is a decision on the petition under 37 CFR 1.137(b), filed December 5, 2005, to revive the above-identified application.

The petition is **DISMISSED**.

The above-identified application became abandoned as a result of petitioner's failure to file an appeal brief (and fee required by 37 CFR 1.17(c)) within the time period provided in 37 CFR 1.192(a). As an appeal brief (and appeal brief fee) was not filed within two (2) months of the Notice of Appeal mailed April 13, 2005, and no extensions of time under the provisions of 37 CFR 1.136(b) were obtained, the appeal was dismissed and the proceedings as to the rejected claims were terminated. See 37 CFR 1.192(b) & 1.197(c). As no claim was allowed, the above-identified application became abandoned as of midnight on July 13, 2005. See MPEP 1215.04.

A grantable petition under 37 CFR 1.137(b) must be accompanied by a terminal disclaimer in certain situations.

Per MPEP 711.03(c) under "G. Terminal Disclaimer Requirement,"

[A] terminal disclaimer (and fee) is ... required for a utility or plant application filed on or after June 8, 1995, but before May 29, 2000, where the application became abandoned (1) during appeal, (2) during interference, or (3) while under a secrecy order. The reason being that utility and plant patents issuing on applications filed on or after June 8, 1995, but before May 29, 2000, are eligible for the patent term extension under former 35 U.S.C. 154(b) (as a result of the Uruguay Round Agreements Act (URAA)). See 35 U.S.C. 154(b) (1999); see also 37 CFR 1.701. If such an application is abandoned (1) during appeal, (2) during interference, or (3) while under a secrecy order, the patentee of a patent issuing from such an application is eligible for patent term extension for the entire period of abandonment. The requirement for a terminal disclaimer for these situations will make certain that any patent term extension obtained for the period of abandonment while the application is under appeal, interference, or a secrecy order will be dedicated to the public. For utility and plant applications filed on or after May 29, 2000, a terminal disclaimer (and fee) is not required since the period of abandonment is reduced from the patent term adjustment pursuant to 37 CFR 1.704.

7 month OA.

File No:	70-568
Attorney:	MDA
Due Date:	04-28-06
Docketed:	03-13-06

The instant application was filed between June 8, 1995, and May 29, 2000. The instant application became abandoned during appeal. Therefore, a terminal disclaimer must be filed. A blank terminal disclaimer form is attached.

The Office notes a non-final Office action was mailed on February 27, 2006. However, the application is abandoned. Therefore, the February 27, 2006, Office action is vacated.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. No further petition fee is required for the request. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

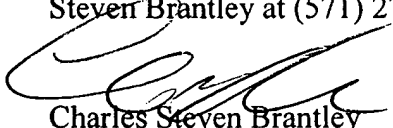
Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.



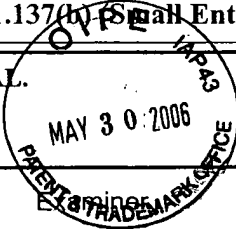
Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

Attached: PTO/SB/63 - Terminal Disclaimer Form

**Petition For Revival Of An Application For Patent Abandoned
Unintentionally Under 37 CFR 1.137(b) (Small Entity)**

Docket No.
98-084

In Re Application Of: JAY S. WALKER ET AL.



Application No.	Filing Date	Inventor(s)	Customer No.	Group Art Unit	Confirmation No.
09/223,901	December 31, 1998	ROBINSON, Boyce Akiba K.	22927	3623	4361

Invention:

SYSTEM AND METHOD FOR ENCOURAGING COMPETITIVE PARTICIPATION IN AN AUCTION

Attention: Office of Petitions
Mail Stop Petition
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

COPY

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (703) 305-9282.

The above-identified application became abandoned for failure to file a timely and proper response to a notice or action by the Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the Office notice or action plus any extension of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee--required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

1. ☒ A proposed reply to the above-identified Office Action:

☒ is enclosed. ☐ was filed on _____

The proposed reply is in the form of: _____

2. ☐ The issue fee:

☐ is enclosed. ☐ was paid on _____

3. ☒ Applicant claims small entity status. See 37 CFR 1.27

4. ☒ The abandoned application was a:

☐ design application. ☒ utility application. ☐ plant application.

5. ☐ A terminal disclaimer (and fee) disclaiming a period equivalent to the period of abandonment is enclosed.

6. ☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

**Petition For Revival Of An Application For Patent Abandoned
Unintentionally Under 37 CFR 1.137(b) (Small Entity)**

Docket No.
98-084

In Re Application Of: **JAY S. WALKER ET AL.**

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
09/223,901	December 31, 1998	ROBINSON, Boyce Akiba K.	22927	3623	4361

Invention:

SYSTEM AND METHOD FOR ENCOURAGING COMPETITIVE PARTICIPATION IN AN AUCTION

Calculation and Payment of Fees

Enclosed are the following fees:

- | | |
|---------------------------------------------------------------------------------------------------|-----------------------------|
| 7. <input checked="" type="checkbox"/> Petition fee under 37 CFR 1.17(m) in the amount of: | <u>\$750.00</u> |
| 8. <input type="checkbox"/> Fee for amendment in the amount of: | <u> </u> |
| 9. <input type="checkbox"/> Fee for extension of time to reply to Office Action in the amount of: | <u> </u> |
| 10. <input type="checkbox"/> Issue fee in the amount of: | <u> </u> |
| 11. <input checked="" type="checkbox"/> Continuing application filing fee in the amount of: | <u>\$395.00</u> |
| 12. <input type="checkbox"/> Terminal disclaimer fee in the amount of: | <u> </u> |
| 13. <input type="checkbox"/> _____ | <u> </u> |
| Total fees enclosed: | <u>\$1,145.00</u> |

The fee of **\$1,145** is to be paid as follows:

- ☐ A check in the amount of the fee is enclosed.
- ☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. **500271**
- ☐ Payment by credit card. Form PTO-2038 is attached.

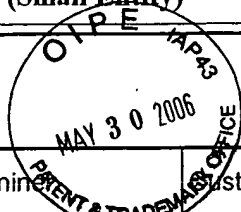
WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

**Petition For Revival Of An Application For Patent Abandoned
Unintentionally Under 37 CFR 1.137(b) (Small Entity)**

Docket No.
98-084

In Re Application Of:

JAY S. WALKER ET AL.



Application No.

09/223,901

Filing Date

December 31,

Examiner

ROBINSON, Boyce Allen R.

Customer No.

22927

Group Art Unit

3623

Confirmation No.

4361

Invention:

SYSTEM AND METHOD FOR ENCOURAGING COMPETITIVE PARTICIPATION IN AN AUCTION

Statement

The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.

**PETITION FOR REVIVAL OF ABANDONED APPLICATION
PURSUANT TO 37 C.F.R. 1.137(b).**

Through a review of the above-referenced case, it has come to Applicants' attention that the time limitation for follow up to the filing of a Notice of Appeal allowed by the USPTO was unintentionally missed.

Please find enclosed Transmittal Letter, Petition For Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b) (Small Entity), Amendment Transmittal Letter, Request for Continued Examination (RCE) Transmittal and Amendment for your review and acceptance.

The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. Therefore, entry of the enclosed documents and revival of this application is respectfully requested.

Signature

Dated: November 30, 2005

Dean P. Alderucci
Attorney for Applicants
PTO Registration No. 40,484
Walker Digital, LLC
203.461.7337/phone
203.461.7018/fax

Dalderucci@walkerdigital.com

CC:

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on

November 30, 2005

(Date)

Signature of Person Mailing Correspondence

Veronika S. Lelievre

Typed or Printed Name of Person Mailing Correspondence

Doc Code:



PTO/SB/30 (04-05)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**REQUEST
FOR
CONTINUED EXAMINATION (RCE)
TRANSMITTAL**

Address to:
Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

COPY

Application Number	09/223,901
Filing Date	December 31, 1998
First Named Inventor	Walker, Jay S.
Art Unit	3623
Examiner Name	Robinson, Boyce Akiba K.
Attorney Docket Number	98-084

This is a Request for Continued Examination (RCE) under 37 CFR 1.114 of the above-identified application.

Request for Continued Examination (RCE) practice under 37 CFR 1.114 does not apply to any utility or plant application filed prior to June 8, 1995, or to any design application. See Instruction Sheet for RCEs (not to be submitted to the USPTO) on page 2.

1. Submission required under 37 CFR 1.114

Note: If the RCE is proper, any previously filed unentered

and amendments enclosed with the RCE will be entered in the order in which they were filed unless applicant instructs otherwise. If applicant does not wish to have any previously filed unentered amendment(s) entered, applicant must request non-entry of such amendment(s).

- a. ☐ Previously submitted. If a final Office action is outstanding, any amendments filed after the final Office action may be considered as a submission even if this box is not checked.
- i. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on _____
- ii. ☐ Other _____

b. ☒ Enclosed

- i. ☒ Amendment/Reply
- ii. ☐ Affidavit(s)/Declaration(s)
- iii. ☐ Information Disclosure Statement (IDS)
- iv. ☒ Other Petition to Revive, Amd't Trans'l Lt., & Postcard

2. Miscellaneous

- a. ☐ Suspension of action on the above-identified application is requested under 37 CFR 1.103(c) for a period of _____ months. (Period of suspension shall not exceed 3 months; Fee under 37 CFR 1.17(i) required)
- b. ☐ Other _____

3. Fees The RCE fee under 37 CFR 1.17(e) is required by 37 CFR 1.114 when the RCE is filed.

- a. ☒ The Director is hereby authorized to charge the following fees, any underpayment of fees, or credit any overpayments to Deposit Account No. 500271. I have enclosed a duplicate copy of this sheet.
- i. ☒ RCE fee required under 37 CFR 1.17(e)
- ii. ☐ Extension of time fee (37 CFR 1.136 and 1.17)
- iii. ☒ Other Petition fee to Revive an Unintentionally Abandoned Application
- b. ☐ Check in the amount of \$ _____ enclosed
- c. ☐ Payment by credit card (Form PTO-2038 enclosed)

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

Signature		Date	November 30, 2005
Name (Print / Type)	Dean P. Alderucci	Registration No.	40,484

CERTIFICATE OF MAILING OR TRANSMISSION

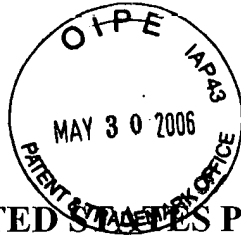
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 or facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below.

Signature	
Name (Print / Type)	Veronika S. Leliever
Date	November 30, 2005

This collection of information is required by 37 CFR 1.114. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing the burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PATENT



Application No. 98-084
Attorney Docket No.: 09/223,901

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CUSTOMER NO. 22927

Applicants: Walker et al.
Application No.: 09/223,901
Filed: December 31, 1998
Title: SYSTEM AND METHOD FOR ENCOURAGING
COMPETITIVE PARTICIPATION IN AN AUCTION
Attorney Docket No. 98-084

COPY

Group Art Unit: 3623
Examiner: A. Robinson-Boyce

AMENDMENT AND RESPONSE

Dear Examiner:

Entry of the following amendments and consideration of the following remarks into the above identified application are respectfully requested.

This document is being filed by the Applicants' representative on behalf of the present Applicants for patent. Accordingly, references to "we", "us" "our" and the like all indicate the present Applicants for patent. References to "you", "your" and the like all indicate the present Examiner.

C L A I M A M E N D M E N T S

The following is a complete listing of all claims ever presented in the present application, including the text of all pending claims and withdrawn claims.

Claims **1-66** are pending.

Claims **1, 50, 54, and 59-66** are independent.

1. (PREVIOUSLY AMENDED) A method for providing a reward to a bidder participating in an auction, the method comprising:
 - identifying a product subject to bidding during an auction session;
 - receiving a bid for the product from a bidder during the auction session;
 - determining, based on a reward rule, whether the bidder is qualified to receive a reward other than the product, and if the bidder is qualified:
 - transmitting, across a computer network to the bidder, an indication that the bidder is qualified to receive the reward.
2. (PREVIOUSLY PRESENTED) The method of claim 1, further comprising:
 - determining, based on the bid, whether the bidder is qualified to receive the product; and if the bidder is qualified:
 - transmitting to the bidder, an indication that the bidder is qualified to receive the product.

3. (PREVIOUSLY PRESENTED)The method of claim 2, wherein the step of determining, based on the bid, whether the bidder is qualified to receive the product, further comprises:

determining whether the bid is greater than each of a plurality of remaining bids.

4. (PREVIOUSLY PRESENTED)The method of claim 1, wherein the reward comprises at least one of:

a value of currency, a supplement to the bid, a rebate on the product, an amount of frequent flier miles, a second product, and a warranty for the product.

5. (PREVIOUSLY PRESENTED)The method of claim 1, wherein the reward rule comprises a condition that the bidder accept an offer provided by a third party.

6. (PREVIOUSLY PRESENTED)The method of claim 5, further comprising:
transmitting, before the determining step, an offer to the bidder for a second product provided by the third party;

receiving an acceptance of the offer from the bidder; whereby the bidder is qualified to receive the reward.

7. (PREVIOUSLY PRESENTED)The method of claim 6, wherein the second product is a service.

8. (PREVIOUSLY PRESENTED)The method of claim 7, wherein the service is a credit card account and wherein the third party is a credit card provider.

9. (PREVIOUSLY PRESENTED)The method of claim 6, wherein the reward is a supplement to the bid, the supplement including a value of currency.
10. (PREVIOUSLY PRESENTED)The method of claim 5, further comprising:
determining whether the bidder has an acceptable credit history before the offer is transmitted to the bidder.
11. (PREVIOUSLY PRESENTED)The method of claim 1, further comprising:
receiving at least one bid for the product from each of a plurality of remaining bidders.
12. (PREVIOUSLY PRESENTED)The method of claim 11, wherein the step of receiving at least one bid is performed prior to the step of receiving the bid.
13. (PREVIOUSLY PRESENTED)The method of claim 12, wherein the reward includes a condition that the bid from the bidder is greater than each bid received from the plurality of remaining bidders.
14. (PREVIOUSLY PRESENTED)The method of claim 12, further comprising:
determining which of the at least one bids is a greatest bid.
15. (PREVIOUSLY PRESENTED)The method of claim 14, wherein the reward rule comprises a condition that the bid from the bidder is greater than the greatest bid by a predetermined percentage.

16. (PREVIOUSLY PRESENTED)The method of claim 14, wherein the reward rule comprises a condition that the bid from the bidder is greater than the greatest bid by a predetermined currency value.

17. (PREVIOUSLY PRESENTED)The method of claim 1, wherein the reward rule comprises a condition that the bid is a first received bid.

18. (PREVIOUSLY PRESENTED)The method of claim 17, wherein the reward is a currency value corresponding to a value of the bid.

19. (PREVIOUSLY PRESENTED)The method of claim 17, wherein the reward corresponds to a difference between the bid and a greatest bid.

20. (PREVIOUSLY PRESENTED)The method of claim 1, in which the establishing step comprises:

establishing the reward rule to include a condition that a greatest bid is at least equal to a predetermined value; and the method further comprising:

receiving a second bid for the product from a second bidder, wherein the second bid is the greatest bid; and

determining whether the greatest bid is at least equal to the predetermined value, whereby if the greatest bid is at least equal to the predetermined value, the bidder is qualified to receive the reward.

21. (PREVIOUSLY PRESENTED)The method of claim 20, wherein the step of determining, based on the reward rule further comprises:

determining, based on the reward rule, whether the second bidder is qualified to receive a reward; and if the second bidder is qualified:

transmitting, to the second bidder, an indication that the second bidder is qualified to receive the reward, whereby if the greatest bid is at least equal to the predetermined value, the second bidder is qualified to receive the reward.

22. (PREVIOUSLY PRESENTED)The method of claim 1, in which the establishing step further comprises:

establishing the reward rule including a condition that the bid exceed a prior bid, the method further comprising:

receiving a prior bid, wherein the determining step further comprises:

determining whether the bid is greater than the prior bid; whereby if the bid is greater than the prior bid, the bidder is qualified to receive the reward.

23. (PREVIOUSLY PRESENTED)The method of claim 22, wherein the reward rule further includes a condition that the bid exceed a prior bid by a predetermined value; and

wherein the step of determining whether the bid is greater than the prior bid further comprises:

determining whether the bid is greater than the prior bid by a predetermined value, whereby if the bid is greater than the prior bid by the predetermined value, the bidder is qualified to receive the reward.

24. (PREVIOUSLY PRESENTED)The method of claim 22, wherein the prior bid is received from the bidder.

25. (PREVIOUSLY PRESENTED)The method of claim 22, wherein the prior bid is received from a second bidder.

26. The method of claim 25, wherein the bid is equal to the prior bid, and wherein the bid and the prior bid are a highest bid.

27. (PREVIOUSLY PRESENTED)The method of claim 26, further comprising:
comparing a participation history of the bidder and the second bidder; and
awarding the product based on the comparison.

28. (PREVIOUSLY PRESENTED)The method of claim 1, further comprising:
establishing the reward rule including a condition that the bidder submit a
progressive bid that is greater by at least a predetermined value than a prior bid;
receiving the prior bid from the bidder; and wherein the determining step
further comprises:

determining whether the bid is greater than the prior bid by at least the
predetermined value; whereby if the bid is greater than the prior bid by at least the
predetermined value, the bidder is qualified to receive the reward.

29. (PREVIOUSLY PRESENTED)The method of claim 28, wherein the
predetermined value corresponds to a percentage of the prior bid.

30. (PREVIOUSLY PRESENTED) The method of claim 1, in which the establishing step further comprises:

establishing the reward rule including a condition that the bidder submits a predetermined number of bids, the method further comprising:

receiving at least one prior bid from the bidder; and wherein the determining step further comprises:

determining whether a number of bids from the bidder, including the bid and the at least one prior bid, is at least equal to the predetermined number of bids, whereby if the number of bids is at least equal to the predetermined number of bids, the bidder is qualified to receive the reward.

31. (PREVIOUSLY PRESENTED) The method of claim 1, in which the establishing step further comprises:

establishing the reward rule including a condition that a bidder submit at least two bids within a predetermined amount of time; the method further comprising:

receiving a second bid from the bidder; and wherein the determining step further comprises:

determining whether the bid and the second bid were received within the predetermined amount of time.

32. (PREVIOUSLY PRESENTED) The method of claim 1, further comprising:
measuring a time between the bid and a previous bid from a second bidder;
and in which the establishing step further comprises:

establishing the reward rule including a condition that the bidder is qualified to receive the reward when the time is greater than a predetermined value; and wherein the determining step further comprises:

determining whether the time between the bid and the previous bid is greater than the predetermined value.

33. (PREVIOUSLY PRESENTED) The method of claim 1, further comprising:
measuring a time between the bid and a previous bid from a second bidder;
and in which the establishing step further comprises:

establishing the reward rule including a condition that the bidder is qualified to receive the reward when the time is greater than a predetermined value; and wherein the determining step further comprises:

determining whether the time between the bid and the previous bid is less than the predetermined value.

34. (PREVIOUSLY PRESENTED) The method of claim 1, in which the establishing step further comprises:

establishing a reward rule that a historic participation of the bidder meets a predefined criterion; and wherein the determining step further comprises:

measuring the historic participation of the bidder; and

determining whether the historic participation meets the predefined criterion.

35. (PREVIOUSLY PRESENTED)The method of claim 34, wherein the predefined criterion includes a requirement that the bidder has participated in at least one previous auction session.

36. (PREVIOUSLY PRESENTED)The method of claim 34, wherein the historic participation corresponds to at least one of: a number of previous auctions in which the bidder participated, a number of previous auctions which the bidder won, and an amount of profit earned from the bidder.

37. (PREVIOUSLY PRESENTED)The method of claim 1, further comprising:
receiving personal data from the bidder including at least one of a name, an address and a financial account identifier belonging to the bidder.

38. (PREVIOUSLY PRESENTED)The method of claim 37, further comprising:
verifying the personal data with a third party.

39. (PREVIOUSLY PRESENTED)The method of claim 1, wherein the receiving step includes:
receiving the bid from the bidder over one of a telecommunications network and the Internet.

40. (PREVIOUSLY PRESENTED)The method of claim 1, wherein the product is a service.

41. (PREVIOUSLY PRESENTED)The method of claim 1, further comprising:
providing the reward to the bidder.

42. (PREVIOUSLY PRESENTED)The method of claim 1, further comprising:
receiving, from the bidder, a payment to close the auction session.
43. (PREVIOUSLY PRESENTED)The method of claim 42, wherein the payment
is determined from a parallel auction.
44. (PREVIOUSLY PRESENTED)The method of claim 1, further comprising:
receiving, from the bidder, a payment to extend the auction session.
45. (PREVIOUSLY PRESENTED)The method of claim 44, wherein the payment
is determined from a parallel auction.
46. The method of claim 1, further comprising:
terminating the reward if a higher bid is received from a second bidder.
47. (PREVIOUSLY PRESENTED)The method of claim 1, wherein the reward
rule includes a condition that the reward be issued randomly.
48. (PREVIOUSLY PRESENTED)The method of claim 1, wherein the reward to
be offered is determined based on at least one of:
the bidder's participation history, the bid spread, the product, a statistical
likelihood that the bid will be a greatest bid, and the average highest bid historically
submitted for a similar product.
49. (PREVIOUSLY PRESENTED)The method of claim 1, wherein the receiving
step includes:
receiving an encrypted indication of a time the bid was transmitted.

50. (PREVIOUSLY AMENDED) A method for providing a penalty to a bidder participating in an auction, the method comprising:

identifying a product subject to bidding during an auction session;

receiving, across a computer network, a bid for the product from a bidder during the auction session;

determining before the auction closes, based on a penalty rule, whether the bidder is to receive a penalty; and if the bidder is to receive the penalty:

transmitting, to the bidder, an indication that the bidder is to receive the penalty.

51. (PREVIOUSLY PRESENTED)The method of claim 50, wherein the penalty rule comprises a condition that the bid is less than a current high bid.

52. (PREVIOUSLY PRESENTED)The method of claim 50, wherein the penalty comprises making the bidder ineligible to continue participating in the auction session.

53. (PREVIOUSLY PRESENTED)The method of claim 50, wherein the penalty rule comprises a condition that the bid is less than a predetermined value.

54. (PREVIOUSLY AMENDED) A method for participating in an auction session, comprising:

receiving an identification of a product subject to bidding during an auction session;

transmitting, across a computer network, a bid for the product to an auctioneer during the auction session; and

receiving a reward other than the product in response to the bid.

55. (PREVIOUSLY PRESENTED) The method of claim 54, further comprising:
receiving the product in response to the bid.
56. (PREVIOUSLY PRESENTED) The method of claim 54, wherein the product
is a service.
57. (PREVIOUSLY PRESENTED) The method of claim 54, wherein the
transmitting step is conducted over one of a telecommunications network and the
Internet.
58. (PREVIOUSLY PRESENTED) The method of claim 54, wherein the
transmitting step includes:
transmitting the bid with an encrypted indication of a time the bid was
transmitted.
59. (PREVIOUSLY AMENDED) A method for participating in an auction
session, comprising:
receiving an identification of a product subject to bidding during an auction
session;
transmitting a bid for the product to an auctioneer during the auction session;
and
receiving, across a computer network before the auction session closes, a
penalty in response to the bid.

60. (PREVIOUSLY AMENDED) A computer data signal embodied in a computer-readable carrier wave comprising a segment having computer processing instructions for notifying a bidder that the bidder is qualified to receive a reward other than the product in response to a previous bid submitted during an auction session.

61. (PREVIOUSLY PRESENTED) An apparatus for providing a reward to a bidder participating in an auction, comprising:

means for identifying a product subject to bidding during an auction session;

means for receiving a bid for the product from a bidder during the auction session;

means for determining, based on a reward rule, whether the bidder is qualified to receive a reward other than the product, and

means for transmitting, to the bidder, an indication that the bidder is qualified to receive the reward.

62. (PREVIOUSLY PRESENTED) An apparatus for providing a reward to a bidder participating in an auction, comprising:

a storage device; and

a processor connected to the storage device,

the storage device storing a program for controlling the processor; and

the processor operative with the program to:

identify a product subject to bidding during an auction session;

receive a bid for the product from a bidder during the auction session;

determine, based on a reward rule, whether the bidder is qualified to receive a reward other than the product, and if the bidder is qualified:

transmit, to the bidder, an indication that the bidder is qualified to receive the reward.

63. (PREVIOUSLY PRESENTED) A computer readable medium encoded with processing instructions for implementing a method for providing a reward to a bidder participating in an auction, the method comprising:

identifying a product subject to bidding during an auction session;

receiving a bid for the product from a bidder during the auction session;

determining, based on a reward rule, whether the bidder is qualified to receive a reward other than the product, and if the bidder is qualified:

transmitting, to the bidder, an indication that the bidder is qualified to receive the reward.

64. (PREVIOUSLY PRESENTED) An apparatus for providing a penalty to a bidder participating in an auction, comprising:

means for identifying a product subject to bidding during an auction session;

means for receiving a bid for the product from a bidder during the auction session;

means for determining before the auction closes, based on a penalty rule, whether the bidder is to receive a penalty; and

means for transmitting, to the bidder, an indication that the bidder is to receive the penalty.

65. (PREVIOUSLY PRESENTED) An apparatus for providing a penalty to a bidder participating in an auction, comprising:

a storage device; and

a processor connected to the storage device,

the storage device storing a program for controlling the processor; and

the processor operative with the program to:

identify a product subject to bidding during an auction session;

receive a bid for the product from a bidder during the auction session;

determine before the auction closes, based on a penalty rule, whether the bidder is to receive a penalty; and if the bidder is to receive the penalty:

transmit, to the bidder, an indication that the bidder is to receive the penalty.

66.. (PREVIOUSLY PRESENTED)A computer readable medium encoded with processing instructions for implementing a method for providing a penalty to a bidder participating in an auction, the method comprising:

- identifying a product subject to bidding during an auction session;
- receiving a bid for the product from a bidder during the auction session;
- determining before the auction closes, based on a penalty rule, whether the bidder is to receive a penalty; and if the bidder is to receive the penalty:
 - transmitting, to the bidder, an indication that the bidder is to receive the penalty.

R E M A R K S

Claims 1-66 are pending.

Claims 1, 50, 54, and 59-66 are independent.

Section 101 Rejections

Claims 1 - 59 stand rejected as being non-statutory. We traverse the Examiner's Section 101 rejection.

The Examiner has used an improper standard in rejecting the claims, and has failed to use the proper legal standard for determining compliance with 35 U.S.C. § 101.

The claims are rejected for not being "within the technological arts". Since there is no technological arts requirement, this rejection is improper. See, e.g., Ex parte Lundgren, Appeal No. 2003-2088 (BPAI 2005).

The legal test for the presence of statutory subject matter is only that a claimed process or apparatus produce a "useful, concrete and tangible result". See, e.g., State Street Bank & Trust Co. v. Signature Fin. Group, Inc., 149 F.3d 1368, 1375, 47 U.S.P.Q.2D 1596 (Fed. Cir. 1998), cert. denied, 525 U.S. 1093, 142 L. Ed. 2d 704, 119 S. Ct. 851 (1999)

The claims produce a useful, concrete and tangible result, as described in the present application. For example, claim 1 recites a useful, concrete and tangible result of transmitting, across a computer network to the bidder, an indication that the bidder is qualified to receive the reward. The remaining claims produce similarly useful, concrete and tangible results. Therefore, the claims are necessarily statutory.

Section 102 Rejections

Claims **50, 59 and 64 -66** stand rejected as anticipated by Walker (U.S. Patent No. 6,108,639). We traverse the Examiner's Section 102 rejection. There has been no *prima facie* showing that the claims are anticipated are even obvious.

Independent Claims 50, 59 and 64 – 66 - *penalty received / determined before auction closes*

Claim **50** is a method claim. Claim **64** is a means-plus function claim corresponding to claim **50**. Claim **65** is an apparatus claim corresponding to claim **50**. Claim **66** is a computer-readable medium claim corresponding to claim **50**.

Independent claims **50 and 64 – 66** generally recite:

determining before the auction closes, based on a penalty rule, whether the bidder is to receive a penalty

Independent claim **59** generally recites:

receiving, before the auction session closes, a penalty in response to the bid.

Neither of these limitations is suggested by any of the references of record, either alone or in combination.

The Examiner contends on page 21 of the Office Action that in Walker "the penalty is implemented before the close of the auction since the transaction is still being processed during step 1008". Whether or not this is true, this has no bearing on either limitation discussed above. Step 1008 does not involve in any way either *determining whether the bidder is to receive a penalty* or *receiving a penalty*.

Similarly, the Examiner contends on page 21 of the Office Action that in Walker "the penalty is applied once the CPO is accepted by a seller, not once the customer is bind [sic] to a purchase".

REQUEST FOR CLARIFICATION

We request that the Examiner clarify not only the interpretation of Walker but specifically which portions of Walker (at step 1008 or otherwise) are believed to involve a penalty.

Similarly, the Examiner contends on page 22 of the Office Action that col. 18, lines 3 - 19 (i.e. claim 29) of Walker discloses or suggests that "once a customer accepts the CPO, the auction is still active until it is determined that the item satisfies a description and once this happens, then the customer is bind [sic] to purchase the item".

The basis for this interpretation is unclear. Claim 29 of Walker does not refer to auctions, when auctions are "active" or when an auction becomes "inactive". However, as best as we understand the ambiguous basis for the Examiner's interpretation, the Examiner appears to be arguing that an auction, by definition, can close only after it is determined whether there should be a penalty. If this is true, then that interpretation is certainly contrary to the presently claimed embodiments, which clearly do not adopt this definition.

REQUEST FOR CLARIFICATION

We request that the Examiner clarify not only the interpretation of Walker but specifically which portions of Walker (at col. 18, lines 3 - 19 or otherwise) are believed to involve when an auction closes or when an auction is "active".

Claim Limitations Not Disclosed or Suggested

The Examiner incorrectly asserts on page 6 of the Office Action that these limitations are disclosed by Walker at Col. 16, lines 5-12, ("identifying one or more rules") and Col. 10, lines 10-15, ("buyer charged a fee or penalty"). In fact, neither Walker nor any other references of record suggests these limitations.

Col. 16, lines 5 - 12 disclose the following portion of claim 8 of Walker:

"identifying one or more rules from at least one potential seller of said secondary market item, each of said rules containing one or more seller-defined restrictions;

comparing said purchase offer to said rules to determine whether an accepting seller is willing to accept said purchase offer if said customer-defined condition satisfies said seller-defined restrictions of at least one of said rules;"

This portion of Walker has nothing to do with penalties. This portion of Walker generally involves rules used in determining whether a seller will accept a customer's purchase offer. The remainder of claim 8 of Walker has nothing to do with penalties.

Col. 10, lines 10 - 15 of Walker disclose the following:

"It is noted that if the buyer ultimately fails to purchase the requested item once the CPO is accepted by a seller, the buyer can be charged a fee or a penalty. In this manner, the offer is guaranteed with a general purpose account, for example, using a line of credit on a credit card account."

This portion of Walker clearly does not suggest *determining before the auction closes whether the bidder is to receive a penalty*. Likewise, this portion of Walker clearly does not suggest *receiving a penalty before the auction session closes*. On the contrary, this portion of Walker is merely the condition that, after a bidder wins an auction, the bidder must pay for what was won or else the bidder is penalized. Accordingly, the Walker system cannot determine before the auction closes whether the bidder is to receive a penalty.

This deficiency in Walker was discussed previously. See, e.g., Appeal Brief mailed February 17, 2004, Section 2.3.1. The Office Action does not address this argument, and does not provide any interpretation of the cited portions of Walker.

In an attempt to fit Walker to the present claims, the Examiner had previously contorted Walker to suggest that the auction is not closed "because the buyer has not yet made the purchase". In other words, even after a bidder wins an 'auction' " (if Walker can be said to disclose an auction at all), the auction never closes if the bidder reneges and does not pay for the item.

This interpretation of Walker is not supported by the record. There is nothing in Walker or in any other record of the prior art that discloses or suggests that an auction never closes if the winning bidder does not pay. Similarly, there is nothing in Walker or any other record of the prior art which discloses or suggests that auctions close at a time other than when a winner is chosen.

Further, the only description of a penalty in Walker is at col. 10, lines 10 – 13. That portion of Walker states that "the buyer can be charged a penalty" if the buyer does not ultimately purchase the requested item once the CPO is accepted by a seller. This portion of Walker shows that it is the seller, not the buyer, who accepts. This portion also shows that the penalty in Walker is not "determined before the auction closes." The 'auction' cannot be considered open once the buyer is already bound to purchase the 'auctioned' item, and incidentally no other bids are permitted.

Section 103(a) Rejections

Claims **1 - 49, 51 - 58, 60 - 63** are rejected as being unpatentable over a combination of Walker and Franchi (U.S. Patent No. 5,770,533). We traverse the Examiner's Section 103(a) rejection. There has been no *prima facie* showing that the claims are obvious.

The Independent Claims

Independent claims **1, 54 and 60 - 63** are included in the rejection under Section 103(a).

Claim **1** is a method claim. Claim **61** is a means-plus function claim corresponding to claim **1**. Claim **62** is an apparatus claim corresponding to claim **1**. Claim **63** is a computer-readable medium claim corresponding to claim **1**.

Claim **1 and 61 - 63** recites:

determining, based on a reward rule, whether the bidder is qualified to receive a reward other than the product,

and if the bidder is qualified

transmitting, to the bidder, an indication that the bidder is qualified to receive the reward

Claim **54** similarly recites:

receiving a reward other than the product in response to the bid

Claim **60** similarly recites:

notifying a bidder that the bidder is qualified to receive a reward other than the product

Claim Limitations Not Disclosed or Suggested

All claims rejected under Section 103(a) generally require that a *bidder may receive a reward other than the product*. There has been no showing that the references suggest any such feature.

The Examiner agrees that these limitations are not disclosed by Walker.

However, the Examiner asserts that

(i) Franchi discloses receiving a reward other than the product,

(ii) Franchi is in an analogous art, and

(iii) it would have been obvious to combine Franchi with Walker in a manner that renders the claims obvious. (this third assertion is not made explicit but is inferable since the rejection is purportedly based on the combination of Walker and Franchi)

Franchi does not suggest "a reward other than the product subject to bidding"

Franchi does not even suggest that a bidder in an auction session may receive a reward other than a product. Franchi is directed to a casino operating system for controlling the flow of funds and monitoring gambling activities in a casino or a gaming establishment. Abstract of Franchi.

The portion of Franchi relied upon in the rejection is part of claim 41:

"41. The casino operating system according to claim 39, wherein said player console further notifies the player when the player wins a door prize randomly awarded by said central computer."

Another portion of Franchi that was not cited by the Examiner also discusses a "door prize". Franchi, col. 8, lines 18 - 22 discloses:

"Optional features that may be provided on the player console [of a slot machine] include:

an indication signal located on the control panel [of the player console] to indicate that the player has won a random door price [sic] offered by the casino as a perk to frequent gamblers."

In summary, both these portions of Franchi disclose little more than the random awarding of prizes to a gambler.

Franchi has nothing to do with auctions or even bidding. Using this completely dissimilar system, the Examiner's argument is essentially that:

- (a) Franchi involves neither a bid nor an auction,
- (b) Franchi discloses a randomly awarded prize
- (c) since this prize is not being bid upon in an auction, it is "a reward other than the product [subject to bidding during an auction session]"

However, the flaw in this argument is that Franchi has nothing to do with auctions or even bidding, so there is no *product which is subject to bidding during an auction session*. Thus, Franchi cannot disclose *a reward other than the product subject to bidding*.

Non-analogous art

In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. In re Oetiker, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

Franchi has nothing to do with auctions or even bidding, and is non-analogous.

The Examiner contends that:

"Franchi discloses this limitation [Receive a reward other than the product] in an analogous art for the purpose of showing that participants who place bets can receive an award as an incentive to continue participating."

First, there is no showing that Franchi is analogous. It has nothing to do with the field of Applicants' endeavor, and it is not reasonably pertinent to the particular problem with which the inventors were concerned. There no evidence otherwise.

The Examiner has not provided any evidence relating to the problem, nor why Franchi is pertinent to the problem. The Examiner has not provided any evidence relating to the field of endeavor, nor why Franchi is in the field of endeavor.

Second, Franchi does not provide an award " as an incentive to continue participating". It is a "perk" which is awarded to frequent gamblers. Such gamblers need not continue participating, or continue participating at any rate of play, to receive such an award. There is no evidence otherwise.

The Examiner apparently contends on page 22 of the Office Action that Franchi may be considered analogous because it involves products (which the Examiner interprets as embracing Franchi's "ability to play a gambling game") and rewards (which the Examiner interprets as embracing Franchi's updating a credit balance). Clearly, this tenuous "relationship" has nothing to do with the legal basis for a finding that references are analogous, discussed above.

REQUEST FOR CLARIFICATION

We request that the Examiner clarify whether, under the Examiner's interpretation of Walker, Franchi is (1) in the field of the applicant's endeavor, and if so, why, or, (2) reasonably pertinent to the particular problem with which the inventor was concerned, and if so why.

No Motivation to Modify

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 21 USPQ2d 1941 (Fed. Cir. 1992). Furthermore, **particular findings must be made** as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. In re Kotzab, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000) (emphasis added).

The following motivation to modify and combine Walker and Franchi has been proposed on page 8 of the Office Action:

"It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to receive a reward other than the product with the motivation of incenting bidders to continue bidding."

This statement is generally an allegation that the modification would have been beneficial. However, a motivation to modify only exists where the prior art teaches such a benefit. There is not even an allegation that the prior art demonstrates

the desirability of combining or modifying the references. Similarly, there is not even an allegation that the prior art demonstrates the desirability of solving the problems solved by the claimed inventions. No evidence to the contrary exists in the record.

There simply is no motivation in the prior art of record to modify or combine the references in the manner proposed by the Examiner, or in any other manner that renders the claims obvious.

The Examiner argues on pages 22 - 23 of the Office Action that the motivation to combine the references is that both involve "the implementation of conditional offers in determining a reward". AN overlap or areas of common subject matter is not a motivation for one of ordinary skill in the art to combine particular teachings, so clearly this factual basis (even if true) would not constitute a motivation to combine the references in the manner the Examiner proposes.

REQUEST FOR CLARIFICATION

We request that the Examiner clarify what portions of Franchi can be considered a "conditional offer" and why.

Level of Skill

A factual predicate underlying an obviousness determination is the level of ordinary skill in the art. In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998). The skill level is one component of the inquiry for a suggestion to combine. In re Rouffet, 149 F.3d 1350, 1359 (Fed. Cir. 1998).

Lacking a motivation to combine, there is no prima facie case of obviousness. In re Rouffet, 149 F.3d 1350, 1358 (Fed. Cir. 1998). If examination at the initial

stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent. In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Though required to do so, the Examiner has not set forth any evidence relating to the level of ordinary skill in the art, and has not even alleged what the level of skill in the art would be. The rejection fails for at least this reason.

Based on the present record, one could only conclude that the level of skill is low. No reference cited by the Examiner even addresses any problems that are addressed by the present inventions.

Accordingly, a prima facie case of obviousness has not been made for at least these reasons.

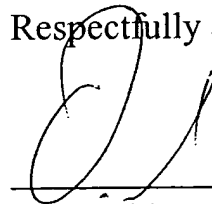
Conclusion

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Dean Alderucci at telephone number 203-461-7337 or via electronic mail at Alderucci@WalkerDigital.com.

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Date

Respectfully submitted,



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